

REMARKS/ARGUMENTS

Claim 1 has been amended to better set forth the physical nature of the composition described in the specification. As explained in the attached Declaration from inventor Yves Vanderveken, the present composition is one where components (a) (resin) and (b) (filler) are intimately mixed together, for example in amounts as described at specification page 10, lines 3-8 ("This content [of filler] is normally less than or equal to 10% by weight, more specifically less than or equal to 5% by weight.")¹ and thus exists as one in which the at least one filler is present in intimate admixture with, and forms a dispersed phase within, the at least one synthetic resin, and in which the at least one synthetic resin forms a continuous phase comprising, therein, the at least one filler in dispersed form. See also, for example, specification page 20, lines 15-23 where 500g of polymer was mixed with 7.5g of dry filler at 50°C for 6 hours in a slow premixer, and specification page 21, line 23 - page 22, line 11 where an emulsion containing 200g resin was coagulated in the presence of 2.5% by weight filler. As discussed in the attached Vanderveken Declaration, each of these procedures results in a composition as claimed in which the at least one filler is present in intimate admixture with, and forms a dispersed phase within, the at least one synthetic resin, and in which the at least one synthetic resin forms a continuous phase comprising, therein, the at least one filler in dispersed form.

Because the amendment to Claim 1 describes the inherent nature of the compositions originally described in the present specification, as supported by Declaration evidence attached hereto, no new matter is entered. As stated in MPEP 2163.07(a) with regard to an

¹ See new claims 25 and 26.

inherent function, theory, or advantage of an invention not explicitly described in a patent specification:

By disclosing in a patent application a device that inherently performs a function or has a property, operates according to a theory or has an advantage, a patent application necessarily discloses that function, theory or advantage, even though it says nothing explicit concerning it. The application may later be amended to recite the function, theory or advantage without introducing prohibited new matter. In re Reynolds, 443 F.2d 384, 170 USPQ 94 (CCPA 1971); In re Smythe, 480 F. 2d 1376, 178 USPQ 279 (CCPA 1973). (emphasis added)

New Claims 25-26 are supported at specification page 10, lines 3-8. New Claims 27-30 are supported by Claim 1. No new matter has been entered.

As the Examiner will appreciate, the composition described in Nakai has nothing to do with Applicants' presently claimed composition. The resin components described by Nakai at paragraphs [0087] - [0090] do not include the elected specie herein (vinylidene chloride) or describe a composition as now detailed in the claims. For example, the "vinylidene chloride resin balloons" described in paragraph [0095] of Nakai are fillers and do not make up a continuous phase.

Accordingly, Applicants request the reconsideration and withdrawal of the outstanding rejection, the expansion of the search from Applicants elected specie now separately claimed in Claim 27, and the rejoinder of withdrawn claims 21 and 22.

Should the Examiner identify allowable subject matter herein he is requested to contact the undersigned in order to expedite the allowance of this case.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.


Richard L. Treanor
Attorney of Record
Registration No. 36,379

Customer Number
22850

Tel: (703) 413-3000
Fax: (703) 413 -2220
(OSMMN 08/07)